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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,784	07/06/2001	Kinya Washino	FNI-02503/03	2825
25006 7590 09/18/2008 GIFTORD, KRASS, SPRINKLE, ANDERSON & CITKOWSKI, P.C PO BOX 7021 TROY, MI 48007-7021				
EXAMINER				
LEE, MICHAEL				
ART UNIT		PAPER NUMBER		
2622				
MAIL DATE		DELIVERY MODE		
09/18/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/900,784

**Applicant(s)**

WASHINO ET AL.

**Examiner**

M. Lee

**Art Unit**

2622

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 51-63 and 65-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-63, 65-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/02)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Reissue Applications***

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/21/08 has been entered.
2. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:
  - 1) The "duty to disclose" statement is improper because it does not properly reference 37 CFR 1.56.
  - 2) It fails to clearly identify an error being corrected in the instant application in accordance with 37 CFR 1.173 (see MPEP 1414, part II).
3. Claims 51-63, 65-77 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

4. The attempt to incorporate subject matter into this application by reference to the patents as stated in page 1 of the specification is ineffective (preliminary amendment dated 7/1/01) because it is not clear what material or limitation is being incorporated or referenced. A mere recitation of "incorporation" or "reference" is improper because it fails to comply with 37 CFR 1.57.

5. The incorporation by reference will not be effective until correction is made to comply with 37 CFR 1.57(b), (c), or (d). If the incorporated material is relied upon to meet any outstanding objection, rejection, or other requirement imposed by the Office, the correction must be made within any time period set by the Office for responding to the objection, rejection, or other requirement for the incorporation to be effective. Compliance will not be held in abeyance with respect to responding to the objection, rejection, or other requirement for the incorporation to be effective. In no case may the correction be made later than the close of prosecution as defined in 37 CFR 1.114(b), or abandonment of the application, whichever occurs earlier.

Any correction inserting material by amendment that was previously incorporated by reference must be accompanied by a statement that the material being inserted is the material incorporated by reference and the amendment contains no new matter. 37 CFR 1.57(f).

6. The continuity statement in page 1 of the specification is objected to because it fails to disclose all the copending patent applications and reissue applications.

7. Applicant fails to properly incorporate the Certificate of Corrections which were granted in the original patent or patents. In order to maintain the completeness of the

patent disclosure, it is essential that all the earlier granted Certificate of Corrections are incorporated into the disclosure once it becomes a patent. Further, a clean copy of the specification without brackets or underlining is required (see MPEG 1411.01 for proper procedures to incorporate Certificate of Correction).

8. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01. A copy of the consent from the parent reissue application was filed in this continuation reissue application and the parent reissue application is not being abandoned; therefore, the current consent of assignee is ineffective. A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

9. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b). In addition, when any substantive amendment is filed in the reissue application, which amendment otherwise places the reissue application in condition for allowance, a supplemental oath/declaration will be required. See MPEP § 1414.01.

10. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 51-63, 65-77 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Art Unit: 2622

Receipt of an appropriate supplemental oath/declaration under 37 CFR

1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

See MPEP § 1414.01.

### ***Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 51-69 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 51-68 of copending Application No. 11/003,834. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims encompasses the current claimed invention. For instance, claim 51 of the instant

application has all the elements of claim 51 of the copending application except for minor different functionality descriptions in each element of the respective applications. However, such differences are not patentably distinct because the claimed elements in one application can be used to perform the functions of the other, and vice versa. Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the claimed copending invention so that it could perform the functions as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 51-63, 65-77 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 51-66 of copending Application No. 11/003,580. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims encompasses the current claimed invention. For instance, claim 51 of the instant application has all the elements of claim 51 of the copending application except for minor different functionality descriptions in each element of the respective applications. However, such differences are not patentably distinct because the claimed elements in one application can be used to perform the functions of the other, and vice versa. Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the claimed copending invention so that it could perform the functions as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 51-63, 65-77 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 51-68 of copending Application No. 11/003,579. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims encompasses the current claimed invention. For instance, claim 51 of the instant application has all the elements of claim 51 of the copending application except for minor different functionality descriptions in each element of the respective applications. However, such differences are not patentably distinct because the claimed elements in one application can be used to perform the functions of the other, and vice versa. Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the claimed copending invention so that it could perform the functions as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 51-63, 65-77 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 51-68 of copending Application No. 11/003,576. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims encompasses the current claimed invention. For instance, claim 51 of the instant application has all the elements of claim 51 of the copending application except for



minor different functionality descriptions in each element of the respective applications. However, such differences are not patentably distinct because the claimed elements in one application can be used to perform the functions of the other, and vice versa. Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the claimed copending invention so that it could perform the functions as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

16. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

17. Claims 51-63, 65-77 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The new limitation "computer-readable medium" for simultaneously storing video material with two compression ratios is considered new matter since the original disclosure does not support a medium (singular) for storing the same. Thus, the medium as now claimed is different from the individual media originally disclosed.

***Response to Arguments***

18. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Lee whose telephone number 571-272-7349. The examiner can normally be reached on Monday through Thursday from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran, can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/M. Lee/  
Primary Examiner  
Art Unit 2622